

REMARKS

Claims 1-17 are pending in the application. Claims 1-10 and 13 have been cancelled without prejudice of the subject matter therein. Claims 11 and 17 have been amended and new Claim 27 has been added to further particularly point out and distinctly claim subject matter regarded as the invention. The amendments are supported in the specification and drawings. Thus, no new matter has been added.

Election/Restrictions

The Office Action states:

“the required species election was not between claims 1 and 11, but between ‘Species A as in Figure 4’ and ‘Species B as in Figure 8.’ The examples in support of the restriction requirement are the species depicted in Figures 4 and 8, and as a picture is worth a thousand words, the examiner submits that there is enough information in those two figures to distinguish differences between them. In fewer than a thousand words, at least some differences are that the device of Figure 4 comprises a base with an opening and a flap with the perimeter of the flap defining a cutting edge which cooperates with the opening to perform a cutting action resulting in a single cut product, making the flap a cutting element; however, Figure 8 portrays a device that has a base with several openings and a flap having several depending structures wherein the depending structures mate with the openings to perform a cut resulting in several cut products, with the flap acting as a driving member to simultaneously actuate the depending structures which are each cutting elements. Therefore, the design, function, and effects of the two devices are unconnected. Lastly, 37 CFR 1.141 permits the allowance of more a reasonable number of species given that there is an allowable claim generic to all the claimed species. This does not preclude a restriction requirement between the species, but allows the examiner to rejoin non-elected species that may depend from an allowed generic claim.

The requirement is still deemed proper and is therefore made FINAL.

Since the election of Species A was not accompanied by a listing of all claims readable thereon as required by MPEP §809.02(a), the examiner has chosen claims 1-5, 10-13, and 17 to be readable on Species A.”

Although Applicant provisionally elected to prosecute Species A and the Examiner has attempted to restrict the claims, Applicant's response will address all claims because it appears to be the only way to preserve Applicant's rights without creating a prosecution history estoppel calling into question the scope of any claims granted on this or a subsequent application. Furthermore, Applicant has filed a petition to the Commissioner for a Petition From Requirement For Restriction Under 37 C.F.R. §1.144 to review the restriction requirement. Attached is a copy for the Examiner's convenience (Exhibit A).

Claim Rejection 35 U.S.C. 112

Claims 10 and 17 stand rejected under 35 U.S.C. 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter. Claim 10 has been cancelled without prejudice. Claim 17 has been amended to include the word "substantially" as required by the Examiner.

Accordingly, it is respectfully requested that this rejection be withdrawn.

Claim Rejection 35 U.S.C. 102(b)

Claims 1-2 and 10 stand rejected under 35 U.S.C. 102(b) as being allegedly anticipated by US Patent 2,847,759 issued to Jones. Claims 1-10 have been cancelled without prejudice. Thus, this rejection is moot.

Claim Rejection 35 U.S.C. 103(a)

Claims 3-5, 11-13 and 17 stand rejected as being allegedly unpatentable over Jones in view of US Patent 3,315,753 to Cragg and US Patent 4,573,576 to Krol. Claim 11 is an independent claim. This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.¹

The Office action states:

"Jones discloses the invention substantially as claimed, but is not mounted on a card that supports a medical device system for delivering a foam material. Cragg '753 teaches including a device 108 used for cutting in a kit including a medical device system for delivering a foam material, which allows tools used together to be available in a convenient manner. Therefore, it would have been obvious to include the cutter of Jones with a kit including a medical device for delivering a foam material since it would allow tools used together to be conveniently available. Though Figure 1 of Cragg '753 appears to show a kit as being mounted on a card, there is no support for a card in the specification; however, Krol teaches mounting a kit on a card to provide easy access to the tools within the kit. Therefore, it would have been obvious that the kit of Jones in view of Cragg '753 be mounted on a card to provide easy access to the tools of the kit."

Applicant respectfully disagrees. Amended Claim 11 provides for:

"A cutting device comprising:

a base having an opening with cutting edges;

¹ M.P.E.P § 2143.

a flap articulated with respect to the base, the flap having a shape corresponding to the opening and cutting edges corresponding to the cutting edges of the opening; and

wherein the base is mounted on a card, and the card supports a medical device system, and wherein the medical device system is for delivering a foam material.”

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine Jones with Cragg or Krol. Jones specifically states that its cutting card device is “a device for notching cards of a certain type in the edges thereof to provide notches extending into previously cut openings in the card.” (Col. 1, lines 12-15; Col. 2, lines 41-57). Thus, the invention of Jones is used to cut specific types of cards having previously cut opening. There is no suggestion or motivation to include the cutter of Jones with the kit including a medical device as stated in the office action. Rather, such a motivation has been given by the applicant who first realized the problems presented and discovered a viable solution. Using the applicant’s teaching to modify a prior art reference is an impermissible use of “hindsight.” *In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997).

Moreover, the alleged combination of the prior art would not result in the test for obviousness. The test for obviousness “is not whether one device can be an appropriate substitute for another,” rather, an examiner “must make specific findings establishing why it was ‘apparent’ to use” the combination of the prior arts. Ruiz v. A.B. Chance Co., Fed. Cir., No. 99-1557 (December 2000). “The notion . . . that combined claims can be declared invalid merely upon finding similar elements in separate prior art patents would necessarily destroy virtually all

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patents and cannot be the law under the statute, §103.” Id. There was no motivation in Jones to use the card cutter with a medical device or to mount the card cutter of Jones on a card. In fact, the card cutter of Jones could not feasibly be mounted onto a card since the cutter of Jones is operated using “an opening 11 over which the thumb of one hand is adapted to be placed as the body of the device is grasped in such hand to facilitate the operation of the device.” (Col. 1, lines 63-66). Mounting the cutter of Jones on a card will not allow for ease of operation of the device.

Lastly, the combination of the prior art references do not teach or suggest all the claim limitations. The combination of the prior art references do not teach having a “base having an opening with cutting edges; a flap articulated with respect to the base, ... and wherein the base is mounted on a card, and the card supports a medical device system, and wherein the medical device system is for delivering a foam material” as claimed in Claim 11. As such, for the reasons described above, among others, the prior art references do not suggest or teach all the claim limitations of Claim 11.

Accordingly, it can not be said that the claimed invention is unpatentable over Jones in view of Cragg and Krol for the reasons described above, among others. It is respectfully requested that this rejection be withdrawn.

Dependent Claims

The argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

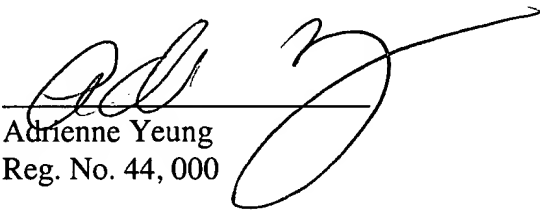
Summary

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,
THELEN REID & PRIEST LLP

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Adrienne Yeung
Reg. No. 44, 000

THELEN REID & PRIEST LLP
P.O. Box 640640
San Jose, CA 95164-0640
(408) 292-5800
(408) 287-8040